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*Rupert B. Hurley Jr.*

**Rupert B. Hurley Jr.**

*March 10, 2010*

**DATE**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

First Named Inventor: Roberto Forloni	Group Art Unit: 1794
Serial No.: 10/565,868	Examiner: Freeman, John D.
Filing Date: July 12, 2006	Attorney Docket No.: D-43535-01
Title: "HIGHLY BIAXIALLY ORIENTED MULTILAYER BARRIER FILM WITH PET TYPE RESINS"	

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
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Alexandria, VA 22313-1450

**REPLY BRIEF UNDER 37 CFR § 41.41**

Sir:

This Reply Brief is filed in response to the Examiner's Answer mailed 3 March 2010, the two-month period for response thereto is set to expire on 3 May 2010. This Reply Brief is being filed on or before 3 May 2010. Appellant respectfully request entry of this Reply Brief and consideration of the remarks below.

### **Appellant's Remarks in Response to the Examiner's Answer**

Page 7 of the Examiner's Answer states that the Examiner disagrees with Appellant's interpretation of the 1152 possibilities as a genus. The Examiner's Answer goes on to state that the 1152 possibilities are distinct species, each of which can be clearly envisaged from Murata et al by one of ordinary skill, and are not a general genus, and that Appellant's argument is to the effect that "...*each* of the 1152 would be novel." [Examiner's Answer, page 7, emphasis added.]

Appellant disagrees. The formulas in Column 12 of Murata et al are of a generic nature. They do not list the individual species they encompass, and to that extent, they are generic formulas in which there are multiple choices for each of the component layers. They contain no specific, express disclosure of Appellant's claimed species. It is error to attribute to Murata et al more than Murata et al discloses. The formulas are clearly generic in nature.

In response to the statement that Appellant's argument is to the effect that "*each* of the 1152 would be novel", Appellant respectfully points out that Appellant's claims encompass only one of the 1152 species within the disclosed genus. Thus, the issue is only whether the single species that Appellant's claims encompass is patentable over the generically disclosed 1152 species within the disclosed genus of Murata et al. The conclusion may be different if Appellant's claims encompass 250 of the 1152 species within the generic teaching of Murata et al. However, Appellant's claims encompass only one of the 1152 species within the generic teaching of Murata et al. The sole question at issue is whether the one species encompassed by Appellant's claims is patentable over the generic teaching of Murata et al, and not whether each of the species individually is novel over Murata et al. Appellant argues only that the claimed species is patentable over Murata et al.

Page 5 of the 27 January 2009 final office action expressly disagrees with Appellant's "ultimate conclusion" that Appellant's invention is novel and nonobvious over Murata et al based on Appellant's 1-in-1152 random odds argument because "...an artisan of ordinary skill would be unlikely to randomly choose each of the claimed components...." [Final office action, page 5]. Page 6 of the final office action goes on to denounce the 1-in-1152 argument with the rationale that "...the choices...are sufficiently limited...." [Final office action, page 6.] Appellant has responded to both of those statements in the Appeal Brief. However, unlike the final office action, the Examiner's Answer goes further in stating, *for the first time*, that:

...Appellant's standard for anticipation is inappropriate.  
[Examiner's Answer, page 7]

While the 1-in-1152 argument has previously been challenged as being non-persuasive for the reasons provided above, the Examiner's Answer is the first instance in which Appellant's 1-in-1152 random odds argument has been challenged as being an "*inappropriate standard*" for consideration in the assessment of novelty and nonobviousness.

In response to this new issue raised for the first time in the Examiner's Answer, Appellant disagrees. The 1-in-1152 random odds argument is not an inappropriate standard for assessing novelty and nonobviousness. Indeed, the 1-in-1152 random odds argument is an appropriate factor to be considered in assessing novelty and nonobviousness.

MPEP 2131.02 is entitled "Genus Species Situations" and is directed at the issue at hand in the instant appeal. MPEP 2131.02 states that the standard is whether one of ordinary skill in the art would have "at once envisaged" the claimed subject matter from the disclosure in the reference. In explaining the "at once envisaged" standard, MPEP 2131.02 cites and

discusses In re Petering, 133 USPQ 275 (CCPA 1962). Regarding Petering, MPEP 2131.02

states:

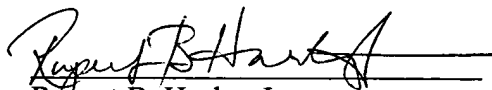
In *In re Petering*, the prior art disclosed a generic chemical formula "wherein X, Y, Z, P, and R" - represent either hydrogen or alkyl radicals, R a side chain containing an OH group." The court held that this formula, without more, could not anticipate a claim to 7-methyl-9-[d, l"-ribityl]-isoalloxazine because the generic formula *encompassed a vast number and perhaps even an infinite number of compounds*. However, the reference also disclosed *preferred substituents* for X, Y, Z, >P,< R, and R" as follows: where X, P, and R" are hydrogen, where Y and Z may be hydrogen or methyl, and where R is one of eight specific isoalloxazines. The court determined that *this more limited generic class consisted of about 20 compounds*. The limited number of compounds covered by the preferred formula in combination with the fact that the number of substituents was low at each site, the ring positions were limited, and there was a large unchanging structural nucleus, resulted in a finding that the reference sufficiently described "each of the various permutations here involved as fully as if he had drawn each structural formula or had written each name." The claimed compound was 1 of these 20 compounds. Therefore, the reference "described" the claimed compound and the reference anticipated the claims. [MPEP 2131.02, *emphasis added*]

The Petering court found that the reference disclosed a "generic formula" encompassing a vast number and perhaps an infinite number of compounds (i.e., species), and that this generic disclosure did not anticipate the claims at issue. Obviously, this lack of anticipation is due to the high number of species encompassed by the generic teachings of the reference, because one of the species within the generic teaching was the species claimed by Petering. However, the Petering court found anticipation based on the disclosure of "preferred substituents" that resulted in a "more limited generic class [that] consisted of about 20 compounds". Thus, the Petering court found no anticipation by the disclosure of a genus encompassing a "vast" or "infinite" number of species, but went on to find anticipation based on the disclosure of preferred substituents that encompassed only 20 species, one of which was the claimed species, i.e., reasoning anticipation by a 1-in-20 analysis.

Appellant points out that the analysis of the Petering court indeed does focus on the number of species in the disclosed genus, applying a “1-in-whatever” analysis in assessing novelty and nonobviousness. Appellant contends that 1-in-1152 random odds argument based on the generic disclosure of Murata et al is much closer to the “vast” number of Petering than the 1-in-20 compounds resulting from the preferred group of substituents disclosed in Petering.

None of the office actions alleges that Murata et al has any disclosure of *preferred* species that include Appellant’s claimed species. As such, the 1-in-20 analysis of *preferred* embodiments disclosed by the reference applied in Petering is not an analysis that applies against Appellant’s claims. Rather, the 1-in-1152 random odds analysis governs the instant appeal. As a result, it is apparent that the PTO has not established that any of Appellant’s claims 15-36 are unpatentable over Murata et al alone or in combination with any other prior art, as 1-in-1152 random odds is too small to result in the claimed species being “at once envisaged”. This burden not having been met by the PTO, Appellant’s claims Claims 15-36 are patentable over the art of record. The rejection of those claims should therefore be reversed, with a view towards allowance.

Respectfully submitted,



Rupert B. Hurley Jr.  
Attorney for Appellant  
Registration No. 29,313  
(864) 433-3247

Sealed Air Corporation  
P.O. Box 464  
Duncan, SC 29334  
March 9, 2010